

REMARKS

This is in full and timely response to the Office Action dated September 20, 2005. Reexamination in light of the following remarks is respectfully requested.

Claims 1-3 and 7 are currently pending in this application, with claim 1 being independent.

No new matter has been added.

Prematureness

Applicant, seeking review of the prematureness of the final rejection within the Final Office action, respectfully requests reconsideration of the finality of the Office action for the reasons set forth hereinbelow. See M.P.E.P. §706.07(c).

Entry of amendment

This amendment *prima facie* places the case in condition for allowance. Alternatively, it places this case in better condition for appeal.

Accordingly, entry of this amendment is respectfully requested.

Claim objection

Paragraph 1 of the Office Action includes an objection to claim 8.

This objection is traversed at least for the following reasons.

While not conceding the propriety of this objection and in order to advance the prosecution of the above-identified application, the features of claim 8 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 8 is now amended claim 1.

The Final Office Action contends prior claim 8 would not further limit claim 1 (Final Office Action of September 20, 2005 at page 2). Accordingly, entry of this amendment is respectfully requested since no “*further search and/or consideration*” would be required.

Withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. §112

Paragraph 3 of the Office Action includes a rejection of claims 1-3 and 7 under 35 U.S.C. §112, second paragraph.

This rejection is traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, the features of claim 8 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 8 is now amended claim 1.

The Final Office Action contends prior claim 8 would not further limit claim 1 (Final Office Action of September 20, 2005 at page 2). Accordingly, entry of this amendment is respectfully requested since no “*further search and/or consideration*” would be required.

In addition 1, the non-final Office Action of April 6, 2005 has failed to include a rejection under 35 U.S.C. §112, second paragraph, of original claim 4, of original claim 5, or of original claim 6.

An Amendment in Response to Non-Final Office Action was filed on June 23, 2005 as a reply to the Office Action of April 6, 2005. Page 5 of the Amendment of June 23, 2005

indicates that original claim 4 has been presented as claim 1, that original claim 5 has been presented as claim 2, and that original claim 6 has been presented as claim 3. Nevertheless, claims 1-3 presented within the Amendment of June 6, 2005 have been rejected by the Examiner in the Final Office Action of September 20, 2005 under 35 U.S.C. §112, second paragraph, as being indefinite (Final Office Action at page 2). Thus, the new rejection of claims 1-3 under 35 U.S.C. §112 made within the Final Office Action is a new ground of rejection that is neither necessitated by applicant's amendment of the claims 1-3 nor based on information submitted in an information disclosure statement.

Accordingly, the rejection at least of claims 1-3 under 35 U.S.C. §112, second paragraph made within the context of a Final Office Action is improper.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Rejections under 35 U.S.C. §102 and 35 U.S.C. §102

Paragraph 5 of the Office Action includes a rejection of claims 1 and 8 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 3,085,615 to Sanderson or, alternatively, U.S. Patent No. 4,153,095 to Sarkissian (Sarkissian '095) or U.S. Patent No. 4,262,724 to Sarkissian (Sarkissian '724) or U.S. Patent No. 5,115,852 to De Lorean.

Paragraph 6 of the Office Action includes a rejection of claims 1, 7 and 8 under 35 U.S.C. §102 as allegedly being anticipated by German Patent Application No. DE 100 51 735 to Warmbier.

These rejections are traversed at least for the following reasons.

While not conceding the propriety of these rejections and in order to advance the prosecution of the above-identified application, the features of claim 8 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 8 is now amended claim 1.

The Final Office Action contends prior claim 8 would not further limit claim 1 (Final Office Action of September 20, 2005 at page 2). Accordingly, entry of this amendment is respectfully requested since no “*further search and/or consideration*” would be required.

The Final Office Action of September 20, 2005 further contends that when there is a reasonable basis for inferring that the structure disclosed by the references inherently possesses the claimed property, applicants must show (not just argue) otherwise (Final Office Action of September 20, 2005 at page 3).

In response to this contention, it is well-settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Regarding USPTO practices and procedures, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). Here, the Final Office Action fails to provide an objective rationale or evidence tending to show inherency. Instead, the Final Office Action merely provides conclusions that are personal in nature.

Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). The courts have not upheld arguments based on “inherent” properties when there is *no supporting teaching in the prior art*. *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). Instead, when the USPTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, the USPTO must produce supporting references. *In re Dillon*, at 1348 (Fed. Cir. 1989).

Claim 1 - Claim 1 is drawn to a tire/wheel assembly, comprising:

an annular tube arranged in a closed space formed between a pneumatic tire and a wheel, an outer sectional area of the tube being nonuniform in a tire circumferential direction,

wherein a sectional area changing rate of the closed space by the tube is 5.0% or higher, and

wherein the sectional area changing rate is represented by:

$$(A2-A1)/(A-A1) \times 100\%$$

“A” being a sectional area of the closed space when the tube does not exist,

“A1” being a minimum value of an outer sectional area of the tube, and

“A2” being a maximum value of an outer sectional area of the tube.

Sanderson - Sanderson arguably teaches a flat tire warning system having a tire 1, a tube 18, and a rim 2 (Sanderson at Figure 4). Sanderson arguably teaches an outer sectional area of the tube 18 being nonuniform in a tire circumferential direction (Sanderson at Figure 3, column 3, lines 30-35).

However, Sanderson is silent as to a sectional area changing rate of the closed space by the tube 18 being 5.0% or higher.

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Office Action of April 6, 2005 at page 2).

In response, this contention is conclusory and is not based upon any objective teaching found within Sanderson. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that Sanderson would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within Sanderson.

Sarkissian '095 - Sarkissian '095 arguably teaches a pneumatic tire having a pneumatic safety insert with beads having a tire 12, an insert member 14, and a rim 16 (Sarkissian '095 at Figure 1).

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 refers to Figure 25 of Sarkissian '095 (Office Action of April 6, 2005 at page 2). In this regard, Sarkissian '095 arguably teaches that one way of notifying a driver of a flat tire is to fashion an out of round condition 140 into the insert crown 48 at a predetermined location as shown in Figure 25 (Sarkissian '095 at column 14, lines 38-40).

However, Sarkissian '095 is silent as to a sectional area changing rate of the closed space by the insert member 14 being 5.0% or higher.

The Office Action contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Office Action of April 6, 2005 at page 2).

In response, this contention is conclusory and is not based upon any objective teaching found within Sarkissian '095. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that Sarkissian '095 would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within Sarkissian '095.

Sarkissian '724 arguably teaches a pneumatic tire having a pneumatic safety insert with beads having a tire 12, an insert member 14, and a rim 16 (Sarkissian '724 at Figure 1).

Sarkissian '724 arguably teaches an outer sectional area of the insert member 14 being nonuniform in a tire circumferential direction (Sarkissian '724 at Figures 6-7). In this regard, Sarkissian '724 arguably teaches the magnitude of the R1 and R2 sections of the insert 14 (Sarkissian '724 at column 8, lines 6-8). Within the table of Sarkissian '724, at column 8, line 51 to column 9, line 11, reference (b) refers to the corresponding circumferential proportion of each ply section (Sarkissian '724 at column 9, line 11).

However Sarkissian '724 is silent as to a sectional area changing rate of the closed space by the insert member 14 being 5.0% or higher.

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Office Action of April 6, 2005 at page 3).

In response, this contention is conclusory and is not based upon any objective teaching found within Sarkissian '724. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534; 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that Sarkissian '724 would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within Sarkissian '724.

Warmbier arguably teaches a tire tube 3 inside a tire 2 (Warmbier at Figures 1-2, Abstract). Warmbier may arguably teach an outer sectional area of the tire tube 3 being nonuniform in a tire circumferential direction (Warmbier at Figures 2-3).

However Warmbier is silent as to a sectional area changing rate of the closed space by the tire tube 3 being 5.0% or higher.

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 contends that the close correspondence of structure and function (reducing resonance inside the tire) between the claimed tire/wheel assembly and the reference tire/wheel assembly provides a reasonable basis for the examiner to infer that the reference tire/wheel assembly also meets the claimed tube cross-sectional area change of at least 5.0%; burden thus shifts to the applicants to show an unobvious difference (Office Action of April 6, 2005 at page 3). Moreover, the Final Office Action contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Final Office Action of September 20, 2005 at page 3).

In response, these contentions are conclusory and are not based upon any objective teaching found within Warmbier. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that Warmbier would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within Warmbier.

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Paragraph 8 of the Office Action includes a rejection of claims 2 and 3 under 35 U.S.C. §103 as allegedly being obvious over Sanderson or, alternatively, Sarkissian '095 or Sarkissian '724 or De Lorean or Warmbier, in view of U.S. Patent No. 5,385,191 to Aflague et al. (Aflague).

This rejection is traversed at least for the following reasons.

While not conceding the propriety of these rejections and in order to advance the prosecution of the above-identified application, the features of claim 8 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 8 is now amended claim 1.

The Final Office Action contends prior claim 8 would not further limit claim 1 (Final Office Action of September 20, 2005 at page 2). Accordingly, entry of this amendment is respectfully requested since no "*further search and/or consideration*" would be required.

Sanderson, Sarkissian '095, Sarkissian '724, and Warmbier, either individually, fail to disclose, teach, or suggest all claimed features at least for the reasons provided hereinabove.

De Lorean - De Lorean arguably teaches a closed-torus tire having a tire 22, an inner wall 24, and a rim 44 (De Lorean at Figure 4).

De Lorean arguably teaches an outer sectional area of the inner wall 24 being nonuniform in a tire circumferential direction (De Lorean at Figures 2-3), and arguably teaches an outer annular chamber 40 and an inner annular chamber 42 (De Lorean at Figure 6, column 4, lines 64-65).

De Lorean additionally provides that mold member 20 has a radial width dimension W varying in a circumferential direction C between a maximum value Mx and a minimum value Mn (De Lorean at Figure 2, column 4, lines 35-38).

However De Lorean is silent as to a sectional area changing rate of the closed space by the inner wall 24 being 5.0% or higher.

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Office Action of April 6, 2005 at page 3).

In response, this contention is conclusory and is not based upon any objective teaching found within De Lorean. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that De Lorean would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within De Lorean.

Aflague - Aflague arguably teaches a tire casing 3 and a binary inner tube (Aflague at Figures 1-2, 4-5 and 7).

Figure arguably shows a cross-section of a deflated inner tube 1 inside a tire casing 3 (Aflague at column 3, lines 20-22).

Figure 2 arguably shows a cross-section of the first embodiment of the present invention having two discrete compartments, a primary compartment 10 and a secondary compartment 20 (Aflague at column 3, lines 22-25).

Figure 4 of Aflague arguably shows a cross-sectional view of the first embodiment of the binary inner tube 1 within a tire casing 3 after the secondary compartment 20 has been inflated because the primary compartment 10 has been deflated, due to damage by puncture, tear in the sidewall, or other means (Aflague at column 3, lines 63-67).

However, Aflague fails to disclose, teach or suggest an outer sectional area of the binary inner tube being nonuniform in a tire circumferential direction (Aflague at Figures 1-2, 4-5). Moreover, Aflague is silent as to a sectional area changing rate of the closed space by the inner wall 24 being 5.0% or higher.

The Final Office Action of September 20, 2005 refers to the prior Office Action of April 6, 2005 for its reasoning in the continued rejection of the claims. The Office Action of April 6, 2005 contends that the skilled artisan would expect the difference in cross-sectional area to fall within the broadly claimed range of at least 5.0% in order to fulfill its function of creating sufficient vibration to be readily detected by the driver (Office Action of April 6, 2005 at page 3).

In response, this contention is conclusory and is not based upon any objective teaching found within Aflague. As noted hereinabove, the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV). In particular, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since the Final Office Action fails to provide any objective evidence to show that Aflague would necessarily possess the characteristics of the claimed invention, the Final Office Action has failed to show that all claimed features are found within Aflague.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: December 14, 2005

Respectfully submitted,

By  

David T. Nikaido

Registration No.: 22,663

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant